

REMARKS

The claims have been amended according to the marked up amendments above. The amendments are supported by the claims, specification and drawings of the application as originally filed. No new matter is believed or intended to have been introduced by the amendments.

In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 103 as supposedly obvious over the combination of U.S. 5,578,015 ("Haseltine") in view of U.S. 6,792,460 ("Oulo"). However, as set forth below, each of the pending claims includes limitations which are not taught or suggested in either Haseltine or Oulo. Accordingly, the applicants request that the pending rejections under section 103 be reconsidered and withdrawn.

The Claims Recite Limitations Which are Not Taught or
Suggested in the Cited Art

Claim 1

Claim 1 is directed to a computerized method for billing for web services which includes the step of "configuring a handler resident on a computer comprising a processor operable to execute computer readable instructions to monitor a web service network communication, between a service requestor and a service provider, for said predefined element in said descriptor file."¹

Haseltine, the primary reference cited against claim 1, clearly does not teach or suggest those limitations. Haseltine is directed to technology for the presentment and payment of bills.² In Haseltine, bill generating entities (e.g., utilities, credit card companies, etc.) would send bill and format data to a payment and presentment database,³ where it would be stored in a staging area.⁴ The bill and format data would then be validated (i.e., checked for errors) and moved from the staging area to an active area⁵ which a customer could access

¹ This step is set forth in the third clause after the preamble of claim 1.

² E.g., Haseltine, col. 1, ll. 8-9.

³ Haseltine, col. 4, ll. 53-57.

⁴ Haseltine, col. 3, ll. 8-10.

⁵ Haseltine, col. 5, ll. 54-63; col. 3, ll. 10-14.

to view his or her bill data in a format specified in the format data.⁶ After the customer has paid his or her bill (or upon a request from the bill generating entity), the bill data would be moved to an archive area.⁷ Once moved to the archive area, the bill data would still be viewable, but could no longer be altered.⁸ As set forth in Haseltine, the presentment and payment database could be configured not only to provide a tool for presenting billing data to customers, but also to support additional functionality. This can include features such as maintaining an audit trail of database activity,⁹ or providing notifications of events such as customers registering with the system or paying their bills.¹⁰

In rejecting claim 1, the Office Action asserted that the limitations of “configuring a handler ... to monitor a web service network communication, between a service requestor and a service provider, for said predefined element in said descriptor file” were taught in lines 1-30 of column 3, and lines 31-46 of column 11 of Haseltine.¹¹ By way of explanation, the Office Action stated that the “predefined element” was taught by a “payment cycle” in Haseltine, that the “service requestor” was taught by Haseltine’s “customer,” and that the “service provider” was taught by Haseltine’s “biller.”¹² In response, as an initial point, the applicants note that, the “payment cycle” of Haseltine is not something that is stored in any kind of a file. Instead, the words “payment cycle” only appear in Haseltine as part of the phrase “bill generation and payment cycle,” which Haseltine uses to refer to processes by which bills are provided to, and paid by, a customer.¹³ Further, even if Haseltine did teach or suggest that a “payment cycle” is something in a descriptor file, the rejection of claim 1 would still be improper because Haseltine does not teach or suggest configuring any component to monitor a web service network communication between a customer and a biller (which Haseltine mapped to the “service requestor” and “service provider”). This is because Haseltine discloses a bill payment and presentment system which would, at most,

⁶ Haseltine, col. 6, ll. 6-9.

⁷ Haseltine, col. 7, ll. 15-19.

⁸ Haseltine, col. 7, ll. 22-25.

⁹ Haseltine, col. 12, ll. 27-33.

¹⁰ Haseltine, col. 12, ll. 37-46.

¹¹ Office Action at 2.

¹² Office Action at 2.

¹³ See Haseltine, col. 1, ll. 34-35 (“FIG. 1 shows an example of a paper-based bill generation and payment cycle 100.”); col. 4, ll. 11-12 (“FIG. 1 shows an example of a paper-based bill generation and payment cycle.”); col. 4, ll. 13-15 (“FIG. 2 shows an electronic bill generation and payment cycle, according to an embodiment of the

only be used to present web service billing data to a user after the web service network communication was complete.¹⁴

Lines 1-30 of column 3, and 31-46 of column 11 of Haseltine do not teach or suggest monitoring a web service network communication between a service requestor and service provider, or that the monitoring is for a predefined element in a descriptor file. Lines 1-30 of column 3 describe how in the system of Haseltine, billing and format data is sent to a presentment and payment database, stored in a staging area, validated, and moved to an active area where it can be accessed by a customer.¹⁵ That section of Haseltine also describes how historical data can be moved into an archive,¹⁶ and that the bill format data can include templates which specify the appearance of the billing data.¹⁷ Lines 31-46 of column 11 describe how a biller can submit billing and format data to a translator to be transformed into a format suitable for storage in the presentment and payment database. Neither of those sections even mentions a web service network communication between a service requestor and a service provider, let alone mentioning configuring a component to monitor such a communication for a predefined element in a descriptor file. Accordingly, the applicants submit that the rejection of claim 1 is improper and should be withdrawn because a *prima facie* case of obviousness has not been (and cannot be) made out for that claim.

After setting forth the rejection of claim 1 discussed above, the Office Action stated that the limitations discussed above are recitations of intended use, rather than positive limitations, and are therefore taught by any structure capable of performing the intended use.¹⁸ To the extent that this statement was intended to justify the rejection of claim 1, the applicants submit that it was clearly inadequate for at least three reasons. First, Haseltine *cannot* perform the limitations identified as recitations of intended use (i.e., configuring the handler ... to monitor a web service network communication) because Haseltine operates well after any web service network communications have been completed, and so lacks even

present invention.”); col. 11, ll. 31-33 (“FIG. 2 illustrates an electronic bill generation and payment cycle 200, according to an embodiment of the present invention.”).

¹⁴ The applicants note that Haseltine does not actually disclose that billing information in the presentment and payment database comprises charges for web services. However, as set forth in the text, even if it did, that billing information would not be sufficient to justify the rejection of claim 1.

¹⁵ Haseltine, col. 3, ll. 1-18.

¹⁶ Haseltine, col. 3, ll. 19-22.

¹⁷ Haseltine, col. 3, ll. 22-30.

¹⁸ Office Action at 4.

the capability of performing the step recited in claim 1. Second, even if Haseltine could perform the configuring step of claim 1, it would be insufficient to justify the rejection of claim 1, because the intended use rule is not applicable to method claims. The authority cited in the Office Action in support of its application of the intended use rule, MPEP 2114 and *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987), both deal with apparatus claims and are inapplicable.¹⁹ When dealing with method claims, it is well established that a new use for an old apparatus can be patented.²⁰ Third, even if the intended use rule did apply to method claims, it does not apply to claim 1, because the limitations discussed above as being absent from Haseltine are positively recited in the claim. In particular, the recited configuring step modifies the handler to perform a specific task. It is well established that this type of modification can be used to patentably distinguish even an apparatus claim from the prior art.²¹ As a result, the applicants submit that the intended use rule cannot be applied to claim 1, and that the Office Action's argument based on that rule is not sufficient to justify the rejection of that claim.

Claims 2-15

With respect to claims 2-15, the applicants submit that those claims are patentable at least because they depend from claim 1, and therefore incorporate the novel and non-obvious limitations of claim 1 discussed above. Additionally, the applicants note that claims 2-15 also include their own limitations which provide independent bases for distinguishing the cited references. For example, claims 2-3 recite that a set of programmed instructions an event record is sent to are configured to (respectively) determine whether an event corresponding to the event record requires authorization, or determine whether an event corresponding to the event record requires rating. In rejecting claims 2 and 3 (as well as every other dependent claim), the Office Action cited *Haseltine*, col. 3, l. 1-col. 4, l. 3, col. 4, ll. 53-67, col. 11, ll. 31-46, and col. 12, ll. 27-46. However, the applicants submit that none

¹⁹ See MPEP 2114 (entitled "**Apparatus and Article Claims** – Functional Language"); *Ex parte Masham*, 2 U.S.P.Q.2d 1647, 48 (BPAI 1987) ("a recitation with respect to the manner in which a claimed **apparatus** is intended to be employed does not differentiate the claimed **apparatus** from a prior art **apparatus** satisfying the structural limitations of that claimed.") (all emphasis added).

²⁰ *E.g.*, 35 U.S.C. 100(b) (defining a process as including "a new use of a known process, machine, manufacture, composition of matter, or material."); MPEP 2112.02 ("Process of Use Claims – New and Unobvious Uses of Old Structures and Compositions May be Patentable") (emphasis in original).

²¹ *E.g.*, *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994).

of those sections could possibly teach or suggest the limitations of claims 2 and 3, because those sections all describe actions which take place after a bill for an event has been generated. As a result, none of those sections can properly be treated as teaching or suggesting instructions configured to determine if an event requires rating or authorization, since those determinations would take place before the event was completed. Similarly, claims 6-11 recite limitations relating to whether a web service transaction may be performed (e.g., by configuring that the service requestor is solvent enough to purchase the transaction, as recited in claim 9). Like the limitations of claims 2 and 3, these limitations necessarily pertain to activities which take place before a web service transaction is completed, and therefore *cannot* be taught or suggested by the cited billing system of Haseltine. Accordingly, even in the event that the rejection of claim 1 is maintained, the applicants submit that the rejections of the dependent claims should be reconsidered and withdrawn based on the additional limitations recited in those claims.

Claim 16

Claim 16 is directed to a tangible computer readable medium having computer executable instructions operable to configure a computer to perform a method comprising monitoring a web service network communication for at least one pre-defined element from a descriptor file. In rejecting claim 16, the Office Action asserted that "utilizing said descriptor file to monitor a network communication for said pre-defined element(s)" was taught in Haseltine, col. 3, ll. 1-67, col. 11, ll. 31-46 and col. 12, ll. 27-46.²² The Office Action also asserted that the limitations of "utilizing said descriptor file to monitor web service" are only recitations of intended use.²³ In response, while not conceding that the intended use argument is properly applied to claim 16, the applicants have amended that claim so that, instead of reciting "utilizing said descriptor file to monitor a web service network communication for said pre-defined element(s)," the second clause after the preamble of that claim recites "monitoring a web service network communication for the at least one pre-defined element from the descriptor file." As discussed in the context of claim 1, monitoring a web service network communication is simply not taught or suggested anywhere in

²² Office Action at 7.

²³ Office Action at 8.

Haseltine, since that reference discloses a system which operates well after the web service network communication would be complete. Accordingly, in light of the amendments to claim 16, and the arguments set forth regarding claim 1, the applicants request that the rejection of claim 16 be reconsidered and withdrawn.

Claims 19-20

With respect to claims 19-20, the applicants note that each of those claims depends from claim 16, and therefore should be allowed for at least the reasons set forth above for that claim. Additionally, the applicants note that claims 19-20 include their own limitations which can provide independent bases for distinguishing the art of record. For example, claim 20 recites that the instructions on the medium of claim 16 are further operable to configure the computer to receive a response from a billing system indicating whether a web service transaction corresponding to the web service network communication should proceed. This type of limitation is clearly not taught or suggested in Haseltine, because the technology of Haseltine operates well after a web service transaction is complete, and so could not teach or suggest receiving a response indicating whether the transaction should proceed. Accordingly, even in the event that the rejection of claim 16 is maintained, the applicants submit that the rejections of the dependent claims should be reconsidered and withdrawn based on the additional limitations recited in those claims.

Claims 21-22

While claims 21-22 are newly presented in this response, the applicants assert that, based on the discussion set forth above, it is clear that claims 21 and 22 are patentable over the cited art. In support of this assertion, the applicants respectfully draw the Examiner's attention to clause (b) of claim 21, which recites "a means for extracting usage and billing authorization data from a web service message stream based on the one or more pre-defined elements designated by the descriptor file." The applicants submit that this clause clearly distinguishes the machine of claim 21 from the cited art, as the cited art does not teach or suggest either the function recited for the means of clause (b),²⁴ or the corresponding

²⁴ In this case, that function is "extracting usage and billing authorization data from a web service message stream based on the one or more pre-defined elements designated by the descriptor file."

structure disclosed in the specification.²⁵ The applicants also draw the Examiner's attention to clause (b) of claim 22. Clause (b) recites that further processing comprises determining whether a transaction corresponding to a web service message stream should proceed. As set forth previously, this type of limitation is clearly not taught or suggested by Haseltine, because Haseltine discloses a system which would be used only after the transaction corresponding to a web service message stream is completed and has been billed. Accordingly, the applicants submit that both claims 21 and 22 are clearly patentable, and should be allowed in their current form.

CONCLUSION

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. § 103. Accordingly, reconsideration and allowance of these claims are earnestly solicited. Further, the applicants submit that the above discussion does not constitute an exhaustive list of novel limitations or reasons why the pending claims should be allowed. To the extent that applicants have not addressed certain aspects of the present rejection, or seem to have adopted certain aspects of the present rejection in the arguments made herein, please do not construe the same as an admission as to the merits of the rejections.

If questions persist or additional matters need to be dealt with prior to allowance, the applicants encourage the Examiner to contact their representative, William Morriss, at (513)651-6915, or wmorriss@ftlaw.com.

²⁵ Structure corresponding to the claimed function appears at various portions of the specification, including paragraphs 45, 81, 104, 106, 109, 110, 129, and 130.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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